The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GRAHAM S. TUBBS and MICHAEL S. CHARTIER

Appeal 2007-0354
Application 09/661,841[1]
Technology Center 2100

Decided: September 12, 2007

Before LEE E. BARRETT, JOSEPH F. RUGGIERO, and LANCE LEONARD BARRY, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Application for patent filed September 14, 2000, entitled, as amended, "Wireless Computing Device Having an Application Wireless Subsystem and Method Therefore."

This is a decision on appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1-21. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

We reverse.

BACKGROUND

The invention relates to a portable device having an application platform with a first processor for executing user application programs, such as e-mail and word processing, and a communication platform having a second processor to process wireless communications. The application platform and the communication platform may be coupled together via an interface that allows the first and second processors to operate independently from each other. The portable device also includes an input port to supply data to the second processor for wireless communication.

Claim 1 is illustrative:

1. A mobile communication device comprising:

a first processor adapted to execute a user application;

a second processor adapted to process a wireless communication, wherein the second processor is capable of initiating the wireless communication independently of the first processor; and

an input port coupled to the first processor and the second processor;

wherein the input port to supply data to the second processor for the wireless communication.

THE REFERENCE

The Examiner relies on the following prior art reference:

Isikoff	US 5,748,084	May 5, 1998

THE REJECTIONS

Claims 1-3, 6-12, and 14-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Isikoff.

Claims 4, 5, and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Isikoff.

The rejection of claims 1-17 under 35 U.S.C. § 112, second paragraph, is withdrawn (Answer 2-3).[2]

DISCUSSION

Dependent claims stand or fall with independent claims

Appellants separately argue the patentability of independent claims 1, 11, and 18. The patentability of the dependent claims stands or falls together with the independent claim upon which they depend.

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[2] The Examiner had rejected claims 1-17 as indefinite under § 112, second paragraph, stating that the "wherein" clause in claims 1 and 11 was either incomplete or grammatically incorrect and stated that "[a]ppropriate correction is required" (Final Rejection 2). Appellants filed a Response to Final Office Action on July 27, 2005, which proposed adding "is configured" to claims 1 and 11. The Examiner denied entry of the amendment in the Advisory Action entered August 15, 2005, stating that the amendment does not place the application in condition for allowance and withdrew the rejection in the Examiner's Answer. We conclude that the claims without the amendment are indefinite and that the amendment would cure the problem. We do not see why entry of the amendment was denied or why the rejection under § 112, second paragraph, was withdrawn. Rather than re-instate the rejection as a new ground of rejection, we assume the amendment will be re-presented and entered before allowance.

Claim 1

Arguments and rejection

Appellants argue that Isikoff at least fails to teach "wherein the second processor is capable of initiating the wireless communication independently of the first processor; and . . . wherein the input port [is configured][3] to supply data to the second processor for the wireless communication," as recited in claim 1 (Re-Amended Appeal Br. 5). Appellants argue that Isikoff discloses a beacon automatically initiating wireless communication to transmit files or data back to the owner or authorized party (Abstract) and discloses the provision of a security code which instructs the beacon to initiate a file-transfer call after which the microprocessor signals the host processor's low level beacon interface software to initiate the transfer (col. 6, ll. 5-13). It is argued that "[b]ecause the microprocessor signals the host computer, this wireless communication is not a wireless communication initiated by the second processor independent of the first processor as recited in Claim 1" (Br. 6).

Appellants note that Isikoff discloses (Abstract; col. 9, ll. 33-37) another wireless communication where the beacon transmits a signal for tracking and recovery of the computer after a theft, but does not describe the source of the transmitted signals, and the source is unlikely to be the input port, so Isikoff does not disclose "the input port to supply data to the second processor for the wireless communication" as recited in claim 1 (Br. 6).

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[3] *See* footnote 2.

Appellants note that the Final Rejection and the Advisory Action assert that Isikoff teaches that the cellular phone transceiver is activated by various voluntary (either the laptop user or a calling party) or automated applications to initiate communication, referring to column 3, lines 9-22, and conclude that the wireless system is capable of initiating communication independently of the first processor (the application subsystem). However, Appellants argue, "these various voluntary and automated applications all operate on the application subsystem (the first processor) and therefore the wireless subsystem (the second processor) does not initiate communication independently of the application subsystem (the first processor)" (Br. 7).

Appellants argues that the Examiner's statement in the Advisory Action that "[t]he term 'transceiver' implies that the beacon is 'capable' of initiation a transfer" (Advisory 2), is incorrect because "transceiver" implies capable of transmitting, without any indication of initiating a transmission (Br. 7).

The Examiner finds the limitation "wherein the second processor is capable of initiating the wireless communication independently of the first processor" to correspond to column 5, lines 45-49 (Answer 4). The Examiner interprets the claim limitation "initiating the wireless communication" to only require initiating or starting the wireless communication independently of the first processor and not that the entire wireless communication is carried out independently of the first processor (Answer 9). The Examiner reads "initiating the wireless communication" on

the microprocessor instructing the data modem to connect (Answer 9). The Examiner concludes that to the extent Appellants imply that "wireless communication" is to be interpreted as "sending" data, the broadest reasonable interpretation includes both "sending" and "receiving" data (Answer 9). The Examiner further notes that claim 1 only recites that "the second processor is *capable of* initiating wireless communication independently of the first processor" and, so, does not positively claim initiating wireless communication independently (Answer 9).

Appellants reply that column 5, lines 45-49, of Isikoff refer to incoming communications and that an *incoming* wireless communication is not a wireless communication initiated by a second processor (Reply Br. 2).

The Examiner finds the limitation "wherein the input port to supply data to the second processor for the wireless communication" to correspond to column 5, lines 20-26, and column 3, lines 5-12 (Answer 4).

Issues

The issues are whether Isikoff discloses the limitations: (1) "wherein the second processor is capable of initiating the wireless communication independently of the first processor"; and (2) "wherein the input port [is configured] to supply data to the second processor for the wireless communication."

Claim interpretation

Proper claim interpretation necessarily precedes a determination of patentability. *See Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) ("Implicit in our review of the Board's anticipation analysis is that the claim must first have been correctly construed to define the scope and meaning of each contested limitation.").

The Specification provides one example of the two limitations (Specification 7: 12-14): "I/O port 25 may also be used to provide communication platform 30 with data. For example, a user may provide the phone number that is to be used to initiate a wireless communication." Consistent with the definition of "initiate" as "to begin or set going : make a beginning of : perform or facilitate the first actions, steps, or stages of," *Webster's Third New International Dictionary* (G. & C. Merriam Co. 1971), we interpret "initiating the wireless communication" to mean beginning the wireless communication. Receiving an incoming call or fax is not "initiating the wireless communication" because communication was begun by the sender; i.e., initiating the acts to receive an incoming call is not the same thing as initiating the communication. Thus, we disagree with the Examiner's interpretation that "initiating the wireless communication" reads on the microprocessor instructing the data modem to connect.

We agree with the Examiner that "initiating the wireless communication independently of the first processor" only requires starting the wireless communication independently of the first processor and not that

the entire wireless communication session is carried out independently of the first processor. The fact that the second processor may later communicate with the first processor is not precluded by the claim language.

We also agree with the Examiner that the broadest reasonable interpretation of "wireless communication" includes both "sending" (transmitting) and "receiving" data. However, "initiating the wireless communication" requires a beginning step of transmitting data.

While we agree with the Examiner that the limitation that "the second processor is *capable of* initiating wireless communication independently of the first processor" does not positively claim initiating wireless communication independently, this does not mean the limitation can be ignored. The term "capable of" is analogous to "for" as a statement of intended use. What is claimed is a mobile communications device structure, and "capable of" limits the structure to structure which can perform the function. This requires some teaching of capability or inherent operation.

As to the limitation "wherein the input port [is configured] to supply data to the second processor for the wireless communication," this limitation does not state when the data is supplied. Thus, it is not limited to the example of providing a telephone number to initiate a wireless communication. It could be data stored at an earlier time and then used in the wireless communication.

Analysis

Isikoff discloses a beacon or transceiver in a laptop computer that allows tracking and alarm functions upon theft of the computer (Abstract). The beacon is shown in Figure 3 and includes a transceiver 10, a data modem and protocol logic 20, a microprocessor 30, and connections to a phone jack 81 and the microphone jack 82. The beacon 101 fits in laptop computer 100 having a processor and communicates with the computer via input/output (I/O) logic 108 and connections to the interface ports as shown in Figure 4, e.g., the phone jack 81 and the microphone jack 82 in Figure 3 (col. 4, ll. 14-23). The laptop processor in Figure 4 corresponds to the claimed "first processor" and the microprocessor 30 in Figure 3 corresponds to the "second processor." Under normal circumstances the beacon functions as the general communications provider for e-mail, voice, data, fax, Internet, or other communications tasks (col. 1, ll. 55-59; col. 8, ll. 14-15); thus, the microprocessor does not normally act independently of the host processor. When sensors detect unusual activity such as removal or tampering with a lock, switch, board, or antenna, they actuate security logic in the beacon to perform actions such erasing the hard drive, calling for help, transmitting important files, or the like (col. 8, l. 62 to col. 9, l. 14).

Isikoff discloses I/O logic 108 coupled to the display and interface ports 112 and the hard drive 102, which constitutes "an input port coupled to the first processor and the second processor."

Isikoff discloses that incoming information is passed to the microprocessor, which determines what actions need to be taken within the beacon and what signals need to be sent to the host computer (col. 5, ll. 20-33). The Examiner relies on this statement in Isikoff (col. 5, ll. 45-49):

> In the event of an incoming data or fax call the microprocessor instructs the data modem to connect and then waits for the modem to produce data. Once data begins to be received, the microprocessor temporarily stores the data in memory and alerts the host processor.

As we concluded in the claim interpretation section, receiving an incoming call or fax is not "initiating the wireless communication" because communication was initiated by the sender; i.e., initiating the acts to receive an incoming call is not the same thing as initiating the communication itself. Thus, although the microprocessor does act "independently of the first processor" to receive calls, it does not initiate the wireless communication.

Isikoff discloses automatically initiating transmissions of certain kinds of data, such as e-mails and file transfers (e.g., col. 7, ll. 37-45). While it sounds like the microprocessor alone perform these tasks because the beacon is responsible for communication tasks, Isikoff describes that to initiate a file transfer call the microprocessor stores the number to which the files are to be transferred as well as the time the transfer takes place and "[t]he microprocessor then signals the host computer's low level beacon interface software to initiate the transfers" (col. 6, ll. 11-13). Thus, this discloses that the first processor initiates the wireless communication and the microprocessor does not act independently of the first processor.

Isikoff still further discloses (col. 9, ll. 15-17): "The beacon may also contain its own back-up battery to enhance the ability of the beacon to operate when power to the main computer is removed or run down." One of the operations is to transmit beacon signals that are externally tracked (col. 9, ll. 33-52), which are a form of wireless communication. Clearly, if the main computer is not powered, "the second processor is capable of initiating the wireless communication independently of the first processor." However, as argued by Appellants (Br. 6), Isikoff does not describe the source of the transmitted signals, and the source is unlikely to be the input port, so Isikoff does not disclose "the input port to supply data to the second processor for the wireless communication" as recited in claim 1. Since the beacon is automatic, it does not require data from the input port. Thus, although Isikoff inherently discloses initiating a wireless communication independently of the first processor, it does not disclose that the input data supplies data to the second processor for the wireless communication.

Therefore, we find that Isikoff does not disclose the limitations "wherein the second processor is capable of initiating the wireless communication independently of the first processor; and . . . wherein the input port [is configured] to supply data to the second processor for the wireless communication." The anticipation rejection of claim 1 and dependent claims 2, 3, and 7-10 is reversed. The Examiner has not provided any reasoning in the obviousness rejection of claims 4 and 5 that would cure

the deficiencies in the anticipation rejection. The obviousness rejection of claims 4 and 5 is reversed.

Claim 11

Appellants argue that Isikoff at least fails to teach "wherein the wireless subsystem [is configured] to initiate a wireless communication with the data from the user independent of the application subsystem" (Br. 8) for the reasons previously argued.

These are essentially the same limitations as addressed with claim 1. Accordingly, the anticipation rejection of claim 11 and its dependent claims 12 and 14-16 is reversed. The Examiner has not provided any reasoning in the obviousness rejection of claim 13 that would cure the deficiencies in the anticipation rejection. The obviousness rejection of claim 13 is reversed.

Claim 18

Appellants argued the Isikoff at least fails to teach "providing other data to a wireless subsystem from the user through the input port to initiate a wireless communication independent of the application subsystem."

These are essentially the same limitations as addressed with claim 1. Accordingly, the anticipation rejection of claim 18 and its dependent claims 19-21 is reversed.

CONCLUSION

The rejections of claims 1-21 are reversed.

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Application 09/661,841

REVERSED

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